The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PETER BRIAN WILSON

Appeal No. 2005-2185
Application No. 09/680,334

HEARD: September 15, 2005

Before KRASS, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 4, and 11-13.

We reverse.

BACKGROUND

The invention relates to the generation of test bitstreams for testing bitstream decoders (e.g., MPEG-4 video and MPEG-4 audio decoders). Claim 1 is reproduced below.

> 1. A method of generating test bitstreams to test a bitstream decoder arranged to decode bitstreams generated in accordance with a predefined syntax, comprising the steps of:
>
> (a) generating test code incorporating the syntax, the test code being arranged when executed to generate a test bitstream dependent on values assigned to a plurality of variables, each variable having a number of interesting values;
>
> (b) executing the test code, including the step of, for each of said variables, assigning that variable one of its interesting values, thereby generating a test bitstream dependent on the interesting value assigned to each variable,
>
> wherein said step (b) is repeated until each variable has been assigned each of its interesting values, whereby a set of test bitstreams is generated.

The examiner relies on the following reference:

Panaro	5,731,839	Mar. 24, 1998

Claims 1, 4, and 11-13 stand rejected under 35 U.S.C. § 102 as being anticipated by Panaro.

Although claims 3 and 5-10 were also rejected over Panaro in the final rejection, the examiner has expressly withdrawn the rejection as to those claims. Claims 3 and 5-10 stand objected to as depending from a rejected claim.

Claim 2 has been canceled.

We refer to the Final Rejection (mailed Oct. 21, 2003) and the Examiner's Answer (mailed Oct. 5, 2004) for a statement of the examiner's position and to the Brief (filed May 21, 2004) and the Reply Brief (filed Dec. 2, 2004) for appellant's position with respect to the claims which stand rejected.

OPINION

Panaro

Independent claim 1 recites "generating test code incorporating the [predefined] syntax, the test code being arranged when executed to generate a test bitstream dependent on values assigned to a plurality of variables, each variable having a number of interesting values...." Independent claim 11 recites "a processor arranged to execute test code incorporating the [predefined] syntax, the test code being arranged when executed to generate a test bitstream dependent on values assigned to a plurality of variables, each variable having a number of interesting values...." Appellant argues, inter alia, that the rejection fails to show where Panaro discloses generating the computer-executable test code as claimed. According to appellant, Panaro's coding algorithm appears to be a standard MPEG coding algorithm, not meeting the terms of the invention that is claimed.

In view of pages 5, 6, and 8 of the Answer, the examiner appears to interpret the test code "incorporating" the syntax as test code "from" the syntax. In relation to this

interpretation, the rejection refers to column 1, lines 24 through 31 of Panaro, which teaches that MPEG standards specify a general coding methodology and syntax for generating a MPEG compliant bitstream, although many variations are permitted in the values assigned to many of the parameters.

Appellant's specification teaches:

> [T]he syntaxes used by MPEG audio and video Standards are defined using pseudo-C and a number of tables which define the meaning of variables referenced in the syntax. It has been found that such syntax specifications can be converted (by a combination of automatic and manual editing) into compilable test code, which can then be executed so as to generate test bitstreams.

(Spec. at 7, ll. 16-21.)

Appellant's disclosure is consistent with the claim term "incorporating." Incorporate means "1. To unite with or blend indistinguishably into something already in existence . . . . 3. To cause to merge or combine together into a united whole." The American Heritage Dictionary, Second College Edition at 652 (1982). A test code "incorporating" the syntax, in light of the specification and consistent with the word's ordinary meaning, requires a test code that is merged or combined with the relevant syntax. The rejection does not show where Panaro discloses a test code incorporating a syntax as claimed.

Moreover, Panaro discloses generating a test bitstream (col. 4, l. 45 - col. 5, l. 17). Although there may be an inherent "generation" of test code, Panaro does not appear to teach generating test code for execution within the constraints of the instant

claims. In Panaro, the generated bitstream is saved in memory (col. 5, ll. 18 - 20), with the CPU recalling the predefined test bitstream from memory and sending the bitstream to the decoder under test, with a viewer observing errors in decoding by means of a video display (col. 3, ll. 32 - 40). The examiner submits (Answer at 10) that Panaro teaches a computer program operable to configure a processing unit to perform a method of generating test bit-streams because the decoder under test can be implemented as a software decoder, referring to Panaro column 3, lines 41 through 49. Whether a decoder is implemented in hardware or in software, however, is inapposite to the claimed subject matter. A decoder receives, rather than generates, a test bitstream.

Because the rejection fails at least to show that Panaro teaches a test code incorporating a syntax as claimed, we do not sustain the rejection of claims 1, 4, and 11-13 under 35 U.S.C. § 102 as being anticipated by Panaro.

Claim 12

Instant claim 12 recites a "computer program operable to" configure a processing unit to perform a method of generating test bitstreams as claimed in Claim 1. The claim does not appear to require that the "program" be embodied in a computer-readable medium that is encoded with the program. The claim could be interpreted as representing a computer listing or an abstract idea, and thus not

statutory under the current Office examination guidelines for computer-related inventions. See Manual of Patent Examining Procedure (MPEP) § 2106 at 2100-13 (8th ed., Rev. 2, May 2004), under the heading "Functional Descriptive Material: 'Data Structures' Representing Descriptive Material *Per Se* or Computer Programs Representing Computer Listings *Per Se*." Instant claim 13, reciting a "carrier medium comprising a computer program as claimed in Claim 12," seems to be consistent with a reading of claim 12 as not requiring that the "program" be embodied in a computer-readable medium. At the oral hearing appellant's counsel indicated that appellant would be amenable to rewrite claim 12, or combine claims 12 and 13, in the interest of ensuring that the claims be drawn to statutory subject matter.

However, we leave it for the examiner to determine what it is that appellant has invented and is seeking to patent with respect to claim 12. Upon return of this application to the examiner's jurisdiction, the examiner should determine for the record why at least claim 12 passes muster, or fails to pass muster, under the current Office examination guidelines for computer-related inventions, and enter new grounds of rejection if indicated.

CONCLUSION

The rejection of claims 1, 4, and 11-13 under 35 U.S.C. § 102 as being anticipated by Panaro is reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

) BOARD OF PATENT APPEALS AND INTERFERENCES

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203